

Serial No. 10/525,259

REMARKS

The claims were amended in accordance with the amendments above. The amendments to the claims are being made merely to clarify the invention. It is believed that all of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

§112 Rejection

Applicant has amended the claims to remove reference to polymer that is not electrically conductive. Accordingly, the rejection to this phrase is rendered moot. Withdrawal of the rejection on this basis is respectfully requested.

With respect to the rejection by the Office to claim 54, step b, and claims 25, 26, 54 and 56, regarding introduction of the term "about," Applicant refers the Office to *Eiselstein v. Frank*, 52 F.3d 1035 (Fed. Cir. 1995). In *Eiselstein*, the Federal Circuit acknowledged that "the word 'about' in a later added claim can broaden an original disclosure that indicates to one skilled in the art that his or her invention is to a precise, not an approximate, amount, range, or limit. Under such circumstances, the term 'about' in the later added claim is new matter and may not receive the benefit of an earlier filing date." *Eiselstein v. Frank*, 52 F.3d at 1040. The Court clarified, however, that "the meaning of the word 'about' is dependent on the facts of a case, the nature of the invention, and the knowledge imparted by the totality of the earlier disclosure to those skilled in the art." *Id.*, emphasis supplied. In *Eiselstein*, at issue was whether a later application was entitled to the benefit of a grandparent application where the original application did not use the term "about" to describe a range of nickel in an alloy. The subject matter of the application was a nickel-based alloy having high strength, ductility, and resistance to corrosion. Representative claims, as presented by the court, were as follows:

1. A nickel-base alloy . . . said alloy consisting essentially of, in weight percent, about 15 to 25% chromium, about 5 to about 15% iron, about 6.5 to 9% molybdenum, about 2.5 to 5% columbium, from 0.5 to 2.5% titanium with the proviso that when the titanium is less than 1% the columbium is at least 3.5%, up to about 0.5% aluminum and *the balance nickel with nickel constituting about 50 to about 60% of the alloy.*

Serial No. 10/525,259

15. A nickel-chromium-iron base alloy . . . said alloy consisting essentially of from 15% to about 25% chromium, about 5% to about 15% iron, about 6.5% to 9% molybdenum, about 2.5 to 5% columbium, from 0.5 to 2.5% titanium, with the proviso that when the titanium is below 1% the columbium is at least 3.5%, up to about 0.5% aluminum and *the balance nickel, the nickel being from about 45% to about 55% of said alloy.*

Emphasis in original.

The Examiner-in-Chief had denied Eiselstein's claim under §120 for benefit of the grandparent application's filing date on the basis that the grandparent did not satisfy the written description requirement of 35 U.S.C. §112 for claims 1-7 and 19 because it described a nickel content of 45 to 55% weight percent, not *about 50 to about 60%*, as required by those claims. The Board upheld this determination and determined that, because the grandparent application did not use the word "about" in reference to the nickel content of the alloys described, the invention of claims 8-18 was not described therein and these claims could not be accorded the filing date of the grandparent application.

Under these circumstances, the Federal Circuit stated that, to meet the requirements under §112 such that the claim to priority was proper, that the grandparent application need not contain precisely the same words as are found in claims 8-18, see *Ralston*, 772 F.2d at 1576, 227 U.S.P.Q. (BNA) at 180; rather, the application simply must indicate to a person skilled in the art that the range 45% to 55% was intended to be approximate, i.e., to mean "about." The court held that it was "clear error to find that a person skilled in the art would not have considered the grandparent application to describe an approximate range of nickel. The later use of the term "about" to describe the range of nickel did not constitute a change to a distinct and different invention." *Id.*

Applicant submits that the facts of *Eiselstein* are analogous to those of the instant case. Here, like *Eiselstein*, Applicant contends that it is clear to one of ordinary skill in the art that the recitation of diameter and/or gap size is an approximate range, and that the use of the term "about" does not constitute a change to a distinct and different invention. Applicant therefore respectfully request favorable reconsideration and withdrawal of the rejection on this basis.

Serial No. 10/525,259

§103 Rejections

Claims 1, 2, 5-16, 18-20, 25, 27-30, 35, 36, 50, 51 and 54-56 were rejected under 35 U.S.C. §103(a) as being obvious over Sanders (US 2003/0211130) in view of Stevens et al. (US 5,686,178) and Tsuruta et al (US 5,389,098). Claims 1, 2, 5-16, 18-20, 25-30, 35, 36, and 49-56 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders et al., Stevens et al., and Tsuruta et al. (of record) as applied to claims 1, 2, 5-16, 18-20, 25, 27, 29, 35, 36, 50, and 54-56 above, and further in view of Coffee et al. (WO 98/03267).

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the Office must give due consideration to all of the limitations of a claim. Obviousness rejections “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). *See, e.g.*, MPEP §§2145, 2144.05. For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of the present claims obvious.

All independent claims now pending clarify that the polymer scaffolds for growing mammalian cells include a “fibre scaffold comprising a lattice or network-like formation” (support for which may be found, for example, at §49 of Applicant’s application). Applicant respectfully contends that the cited art fails to teach and suggest each and every claim feature as now claimed, and in fact, teaches away from the recited “fibre scaffold comprising a lattice or network-like formation” thus supporting a conclusion of nonobviousness. Applicant contends that throughout Sanders et al, the use of linear arrays is taught, and the use of nonlinear, mesh-type arrays (such as the type now claimed) is discouraged. For example, as described in Example I of Sanders et al, linear, parallel microfiber arrays were prepared and used with an electrospun fibro-porous mesh being used as a control. At paragraph 138, Sanders et al. state that:

Serial No. 10/525,259

Unlike the microfiber arrays, results at 9 days showed that the cells in the mesh grew in a highly disorganized fashion and were not able to form an architecture resembling the arterial medial layer. There were many holes within the cell layers, and cells and collagen fibers showed no preferred orientation. Out of plane misalignment of cells occurred because the microfibers were not all in one plane.

Accordingly, Applicant contends that Sanders et al clearly teaches away from the claimed "fibre scaffold comprising a lattice or network-like formation." Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of amended claims 1, 14, 16, 18, 20, and 54 in accordance with MPEP 2143.03, and that a *prima facie* case of obviousness is not established and/or is rendered inapplicable by the present remarks and/or amendments. Accordingly, Applicant respectfully submits that the combined art of record fails to render such claims obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Serial No. 10/525,259

RECEIVED
CENTRAL FAX CENTER

AUG 18 2010

CONCLUSION

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513) 651-6427 or via e-mail at ntepe@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency, including any fees required for an extension of time not already paid for or any other required fees not already paid for, or to credit any overpayment of fees, to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,

/Nicole M. Tepe/



Nicole M. Tepe (Reg. No. 61,521)
FROST BROWN TODD LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202
(513) 651-6427
ntepe@fbtlaw.com

CINLibrary 0004897 . 0578919 2161380v1